

09/723,480



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David E. MCDYSAN et al.

Conf. No.: 7587

Application No.: 09/723,480

Examiner: Bates, K.

Filed: November 28, 2000

Group Art Unit: 2155

Customer No.: 25537

Attorney Docket No.: RIC00044

Client Docket No.: 09710-1234

For: MESSAGE, CONTROL AND REPORTING INTERFACE FOR A  
DISTRIBUTED NETWORK ACCESS SYSTEM

Commissioner for Patents  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

Applicants respectfully request a pre-appeal brief review be made of the present application for at the least the following clear errors.

**I. THE OFFICE ACTION DISREGARDS THE FEATURE OF "RECEIVING A CONTROL MESSAGE FROM THE EXTERNAL PROCESSOR, BY THE PROGRAMMABLE ACCESS DEVICE, TO ESTABLISH A CONFIGURATION OF THE PROGRAMMABLE ACCESS DEVICE"**

The Examiner continues to ignore certain features of claim 1, as follows with added emphasis:

1. A method of communication in a network access system including an external processor and a programmable access device, said method comprising:  
**receiving a control message from the external processor, by the programmable access device, to establish a configuration of the programmable access device;**  
receiving, by the programmable access device, messages from a first network external to the network access system via a first network interface;

communicating a first subset of the received messages from the programmable access device to the external processor for service processing in accordance with the configuration; and

routing a second subset of the received messages not communicated to the external processor from the network access system via a second network interface different from the first network interface to a second network external to the network access system, wherein the second network is different from the first network.

Neither the Final Office Action nor the Advisory Action addresses this feature, which is not found in the combination of *Cohen et al.* and *Bhattacharya et al.*, even if these references could be properly combined. Applicants have pointed out this oversight in Applicants' prior Response dated May 1, 2006 (page 12) as well as the Response dated Nov. 14, 2005 (pages 12-14).

Perhaps in recognition of the oversight, the Advisory Action now attempts to merge the two claim elements, "external processor" and "programmable access device," into one element to selectively satisfy the claims. This approach, which has no basis in law or fact, results in a contortion of the claims and reading of the references. For example, the Advisory Action (page 2) now views the dispatcher process 402 (which has been previously equated to the claimed "external processor") as the claimed "programmable access device," stating "the dispatcher (the programmed device) is configured by one of the many gateway programs to filter certain flows to certain programs meaning they can change the configuration of the dispatcher." This conclusion would not have been plausible under the previous interpretation that the dispatcher process is the external processor, as this would entail changing configuration of the external processor, rather than the programmable access device (as claimed).

Further, assuming, *arguendo*, the interpretation that the dispatcher is the programmable access device as now asserted by the Advisory Action, then it is not possible that the claimed control message is "from the external processor." For instance, the Advisory Action contends

that the dispatcher is configured by the gateway programs; however, the gateway programs are not an “external processor.” This new reasoning runs afoul the Examiner’s reading of other claim language as well. For example, the Final Office Action, page 2, the request for starting or stopping a flow was equated as the claimed control message. This interpretation bears no relevance to the Examiner’s current argument.

It is noted that MPEP § 706 states that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” Furthermore, MPEP § 706.02(j) indicates that: “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to respond.” Unfortunately, the Examiner elects, at this late stage of prosecution, to address Applicants’ argument regarding the claim features of **“receiving a control message from the external processor, by the programmable access device, to establish a configuration of the programmable access device,”** providing only terse explanations of how the references disclose such features. Applicants are left to conjecture on how the Examiner’s new interpretation will affect the rejection of the remaining claim features. 35 U.S.C. § 132 requires the Director to “notify the applicant thereof, stating the reasons for such rejection.” This section is violated if the rejection “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 15 USPQ2d 1333 (Fed. Cir. 1990).

**II. THE OFFICE ACTION RELIES ON IMPERMISSIBLE HINDSIGHT TO MODIFY *COHEN ET AL.* BASED ON THE TEACHINGS OF *BHATTACHARYA ET AL.***

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The Advisory Action, on page 2, asserts “the dispatcher is the programmed device that is forwarding the packets to the decision makers (the gateway servers) the combination involves Bhattacharya’s idea of off loading the decision makers to an external device...the gateway programs are taught to be move externally to the dispatcher.” With this new argument, it is unclear how the Examiner is reading the claims; for example, Applicants do not understand how the term “decision makers” relate to the claims. Notwithstanding this ambiguity, a teaching to off load the gateway programs (which are not the processor of *Cohen et al.*) would not reasonably suggest moving the dispatcher (the supposed processor) external to the gateway.

Originally the Examiner (based on the reasoning in the Final Office Action, page 3) was attempting to justify the motivation for moving the dispatcher 402, which resides within the gateway 400, externally to satisfy the claimed “external processor.” On page 3, the Office Action acknowledges that “Cohen teaches that processor handling some of packets to be process on the programmed gateway, not an external processor,” citing to col. 12: 8-12. This cited passage states the following:

Alternatively, the Combined Policy-matching Engine may be located in an external policy server and policy decisions may be outsourced to this device, while the service specific modules are located at the Policy Enforcement Entity such as the router or firewall.

From this passage, one of ordinary skill would understand that an external policy server can be utilized. In the context of the *Cohen et al.* system, this would suggest that the packet filter 403 can obtain policies from an external policy server, not that the dispatcher process 402 can alternatively reside in an external policy server.

Applicants, therefore, respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

### III. CONCLUSION

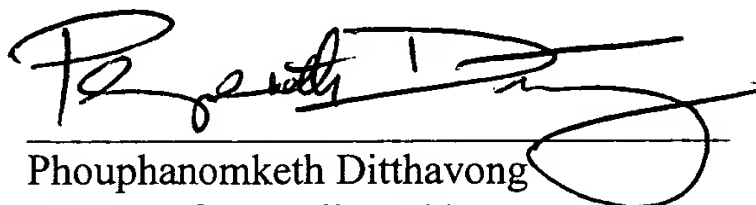
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For the foregoing reasons, the Appeal Brief Panel is respectfully requested to withdraw the rejection of the present application in light of these clear errors and allow the pending claims.

Respectfully Submitted,

DITTHAVONG & MORI, P.C.

6/5/06  
Date

  
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